

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re U.S. Patent Application)

Applicant: Stephen Jensen)

Serial No.: 09/966,553)

Filed: September 27, 2001)

For: CIRCUIT BOARD HAVING
FERRITE CONTAINING
LAYER)

Attorney Docket: 7836/83303)

Art Unit: 2841

Examiner: Ishwarbhai B. Patel

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February 4, 2002.


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RESPONSE TO OFFICE ACTION

Commissioner for Patents
Washington, D.C. 20231

Sir:

This response is being filed in response to the Office Action dated January 3, 2002. The January 3, 2002 Office Action imposed two restriction requirements on the patent application. First, the Office Action required election of product or method claims. Second, the Office Action identified four figures as species and required election of one species. Applicant thanks the Examiner for taking the time yesterday to discuss the species restriction requirement. The applicant provides the required elections below, with traverse, for the reasons stated in the remarks section below. However, should both restriction requirements be maintained, the mandatory elections will be that claims 1, 3-6, 8-15 and 31 are elected for examination.

Remarks

The product/method restriction requirement does not make any showing that the claimed processes can be used to make another and materially different product that the products claimed or that the product can be made by another and materially different process. The rejection cites the possibility of the use of a lumped ferrite element instead of a ferrite layer or the use of a shielding, such as a metal as opposed to ferrite. None of the claims recites lumped ferrite or

metal as an alternative to ferrite. However, should the Examiner not be persuaded by this argument, Applicant elects Group I consisting of claims 1-15 and 31.

The species restriction requirement lists four figures as being different species of the invention. While paragraph 4 of the Office Action indicates that no claims are currently generic to all four species, Applicant respectfully submits that many of the claims read on all four figures. Also, the figures on which the species restriction requirement are based do not illustrate mutually exclusive structures as required by MPEP 806.04(f) ("Claims to be restricted to different species must be mutually exclusive"). For example, the structures of Figures 1 and 2, although different, are not necessarily mutually exclusive as can be seen in the middle layer of Figure 5 which has ferrite layers above and below it. Also, the boards of Figure 1 and Figure 2 can implement a ferrite layer consistent with either the patterning of ferrite illustrated in Figure 7 or Figure 8.

However, should the Examiner not be persuaded to remove the species restriction requirement, Applicant elects Specie I. From the interview with the Examiner, Applicant understands that if the Examiner maintains the restriction that an election of Specie I can include embodiments directed to configurations covered by one of Figure 7 or Figure 8, because the ferrite layer of the embodiment of Figure 1 must have some configuration. Under such an interpretation of the restriction requirement, Applicant submits that claims 1, 3-6, 8-26, 28-31 are related to Specie I with a ferrite configuration consistent with Figure 7.

Should both restriction requirements be maintained, claims 1, 3-6, 8-15 and 31 are commonly elected by the two requirements.

Respectfully submitted,

Dated: February 4, 2002

By: 

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